REMARKS/ARGUMENTS

This Amendment is in response to the Final Office Action mailed November 13, 2008 and the Advisory Action mailed January 21, 2009.

Claims 1, 4-18, 21-35, 38-52 are pending in the present application. Claims 2, 3, 19, 20, 36, and 37 have been canceled by this amendment. Reconsideration and allowance are requested.

Examiner Interview

The Applicant would like to thank Examiner Taylor and his supervisor for the courtesies extended during the telephonic interview conducted on March 23, 2009. At the start of the interview, the Applicant explained that the purpose of the interview was to better understand the rejection of claims 1 and 2 made in the Final Office Action dated November 13, 2008 and maintained in the Advisory Action dated January 21, 2009. During the interview, the Examiner repeated and maintained the arguments made in the Final Office Action and the Advisory Action. The interview was very brief and no agreement was reached.

Claim Rejection under 35 USC 102

In the Office Action, claims 1-11, 15-28, 32-45, and 49-52 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hind et al (U.S. Publication No. 2004/0205555) (hereinafter "Hind"). The Applicant respectfully traverses. The standard for anticipation is set forth in M.P.E.P. § 2131 as follows:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)…. "The identical invention must be shown in as complete detail as is contained in the … claim." Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Applicant submits that original claims 1-11, 15-28, 32-45, and 49-52 are patentable over Hind because each and every element set forth in the claims is not expressly or inherently described in Hind. In the previous response to Final Office Action filed January 12, 2009, the Applicant explained why each and every element of claims 1-11, 15-28, 32-45, and 49-

Appl. No. 10/722,834
Amdt. dated April 8, 2009
Reply to Final Office Action of November 13, 2008

PATENT

52 were not expressly or inherently described in Hind. In summary, the Applicant explained that Hind failed to disclose both the storing feature and the determining feature of previously presented claim 1.

Previously presented claim 1 recited "storing the first request in the notes document upon determining that the portion of the first information requested by the first request is not accessible to the note-taking device." Hind fails to teach or suggest anything that resembles "storing" a request, but instead, only discloses **displaying** a place holder while the screen is refreshed. For example, in paragraph [0032] as well as Figure 3A, Hind appears to only teach that a place holder is displayed until the remainder of the information can be retrieved. Specifically, paragraph [0032] states:

> [0032] Note that the placeholder message displayed instead of portlet content at 320 is merely one way in which absence of a portlet's content can be indicated. Alternatives include displaying an image to fill the space; displaying a message reflecting the portlet's purpose (which may be obtained programmatically from the portlet's properties interface, for example); and leaving the space unoccupied. (When the portlet content eventually arrives and is painted in its place on the portal page, the user ideally will perceive that the portlet's area of the portal page is simply being repainted with its content, rather than the entire page being repainted.)

Clearly, Hind only teaches that a place holder is displayed until all of the information can be downloaded. The Applicant submits that "displaying a place holder" is not the same as "storing the first request...." Those skilled in the art will realize that displaying involves generating an image that is displayed or shown to a user whereas storing involves recording for some later use. Thus, Hind does not teach or disclose "storing the first request in the notes document upon determining that the portion of the first information requested by the first request is not accessible to the note-taking device," as recited in the previously presented claim 1. As further explained below, in order to help clarify this difference claim 1 has been amended to characterize that the first request "identifies a portion of a first information to insert in a first location in the notes document."

Previously presented claim 1 also recited "determining if the portion of the first information requested by the first request is accessible to the note-taking device." As previously argued, Hind fails to teach anything that resembles determining whether information is accessible to a note-taking device, as required by previously presented claim 1. Hind simply assumes that the portion of the first information requested by the first request is accessible to the portal page and pushes that information onto the portal page. Hind does not consider whether the portal page is accessible and pushes the information onto the portal page without making any determination of the portal page's accessibility. Hind only appears to consider the scenario where the server is not ready to deliver the information but the portal page is always accessible and waiting to receive the information. When the portal page does not receive the information the portal page displays a place holder.

The Applicant submits that determining whether the server is ready to deliver information to the portal page is not the same as determining if information is accessible to the portal page. In other words, determining that the server is not ready to deliver the information and therefore only displaying a place holder until the server is ready to deliver the information is **not** the same as determining if the information is accessible to the portal page. In the final Office Action and the Advisory Action, the Examiner asserted:

> [a]s to the argument that Hind determines only what is accessible to the server and not to note-taking device, the Examiner respectfully asserts, without conceding to the presented interpretation of Hind, that whatever is not available to the portal server is accordingly inaccessible to the note-taking device.

The Applicant respectfully disagrees. The Applicant believes that Hind does not address the situation where the portal server is not accessible to receive information but rather only the situation where the portal server is not ready to deliver information. The Examiner's argument that "whatever is not available to the portal server is accordingly inaccessible to the note-taking device," is confusing because the note-taking device can be inaccessible to the portal server but the note-taking device is still accessible to itself (i.e. the note-taking device). As previously argued, in Hind, the portal server may, or may not be, ready to deliver information but the note-taking device is always ready to receive information and is just waiting for the portal

server to push that information onto it. This is different than previously presented claim 1 which recites "determining if the portion of the first information requested by the first request is accessible to the note-taking device." The possibility that the portal server is not ready to deliver information has nothing to do with determining whether the note-taking device is accessible. As further explained below, in order to help clarify this difference the claims have been amended to recite "determining if the note-taking device can communicate with a server."

Therefore, the determining and storing steps of original claim 1 are not found, either expressly or inherently described, in Hind. For at least this reason, claim 1 is patentably distinct over the cited references. The Applicant submits that remaining claims 1, 4-18, 21-35, 38-52 are patentably distinguishable and allowable over Hind for at least a similar rationale as discussed above for the allowability of claim 1.

Nevertheless, in an effort to expedite prosecution, the claims have been amended to be further distinguishable over the cited references. Independent claims 1, 18, 35 and 52 have been amended to further characterize the request and to recite "determining if the note-taking device <u>can communicate with a server</u>; storing the first request in the notes document upon determining that the note-taking device <u>cannot communicate with the server; determining, subsequent to storing the first request in the notes document, if the note-taking device can communicate with the server; and communicating the first request from the note-taking device to the server upon determining that the note-taking device can communicate with the server</u>." The request has been amended to characterize "<u>wherein the first request identifies</u> a portion of a first information <u>to insert</u> in a first location in the notes document." Support for this amendment can be found throughout the originally filed specification including in paragraphs [0063]-[0066] and [0079].

As previously explained, Hind fails to teach or suggest anything that resembles "storing" a request, but instead, only discloses **displaying** a place holder while the screen is refreshed. See for example paragraph [0032] as well as Figure 3A of Hind. The amended claims now recited that the first request, which is stored, "<u>identifies</u> a portion of a first information <u>to insert</u> in a first location in the notes document." This is clearly not disclosed in Hind which only displays a place holder. The Applicant emphasizes that displaying a place holder cannot

reasonably be interpreted to be the same as storing a request. Not only is storing different than
displaying but a request which "identifies a portion of a first information to insert in a first
location in the notes document," is not the same as place holder. The Applicant respectfully
submits that Hind does not disclose this limitation.

Hind also fails to disclose "determining if the note-taking device can
communicate with a server; storing the first request in the notes document upon determining that
the note-taking device cannot communicate with the server; determining, subsequent to storing
the first request in the notes document, if the note-taking device can communicate with the
server; and communicating the first request from the note-taking device to the server upon
determining that the note-taking device can communicate with the server," as recited claim 1.
Hind only addresses the situation where the server is not ready to deliver the information but the
portal page is always accessible and waiting to receive the information. In Hind, when the portal
page does not receive the information the portal page displays a place holder. **Hind never
considers the possibility that the note-taking device cannot communicate with the server**, as
is addressed in the present invention. As such, Hind has no need to determine whether the note-
taking device can communicate with the server. Hind just assumes that the communication
between the note-taking device and the server is established and proceeds accordingly.
Therefore, the Applicant respectfully submits that cited references do not disclose, suggest or
hint at these limitations.

The Applicant believes that none of the cited references teach the limitations
recited in amended claims 1, 4-18, 21-35, and 38-52. Therefore, the Applicant respectfully
requests that, in light of these amendments and remarks, the Examiner reconsider the rejection of
claims 1, 4-18, 21-35, 38-52 under 35 USC 102(e).

Claim Rejection under 35 USC 103

In the Office Action, claims 12-14, 29-31, and 46-48 were rejected under 35
U.S.C. 103(a) as being unpatentable over Hind et al. and Chiu et al (U.S. Patent No. 6,452,615)
(hereinafter "Chiu"). In rejecting claims 12-14, 29-31, and 46-48, the Office Action
acknowledged that Hind fails to teach wherein the first information comprises information

Appl. No. 10/722,834
Amdt. dated April 8, 2009
Reply to Final Office Action of November 13, 2008

PATENT

captured during a first presentation and wherein the portion of the first information is a slide displayed during the first presentation. The Office Action then used Chiu to make up these deficiencies by arguing that "Chiu teaches a method of creating information comprising captures from presentation for insertion in a note document (Chiu, abstract and col. 3, lines 22-57). The information includes slides, audio segments, video segments, and images displayed during the presentation (Chiu, col. 4, lines 47-60; col. 5, lines 8-20; col. 3, lines 22-57; see figs. 3 and 7)."

The Applicant respectfully traverses. As explained in the previous response to Final Office Action and the response filed on February 13, 2008 (responsive to the Office Action dated December 13, 2007), original claims 12-14, 29-31, and 46-48 are allowable over the combination of Hind and Chiu. Additionally, claims 12-14, 29-31, and 46-48 have been amended be further distinguishable over combinations Hind and Chiu and are patentably distinct over Hind and Chu in light of the amendments alone.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

/Jesus Del Castillo/

Jesus Del Castillo
Reg. No. 51,604

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400 / Fax: 415-576-0300
JDC:gjs
61846191 v1